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10/800,386	03/12/2004	Takahiro Saito	EHAR0004-D2	8854

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EXAMINER

CAPUTO, LISA M

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/800,386
Filing Date: March 12, 2004
Appellant(s): SAITO, TAKAHIRO

Jiawei Huang (Reg. No. 43,330)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10 October 2006 appealing from the Office action mailed 30 June 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Letter "C" indicates that "claims 6-14 would be rejected under 35 U.S.C. 102(d) as anticipated by Japanese Unexamined Patent Publication No. 11-161757 (Japanese patent application number No. 9-328040)", although there was mention of a possible future 102(d) rejection indicated on the Advisory Action mailed 30 September 2005, this rejection was never actually made and hence is not an issue for appeal:

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,375,075	Ackley et al.	4-2002
6,073,842	Yoshinaga	6-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ackley et al. (U.S. Patent No. 6,375,075, from hereinafter "Ackley").

Ackley teaches a method and apparatus for reading machine-readable symbols including color symbol elements. Regarding claim 6, Ackley teaches an information code (color machine-readable symbol 12) comprising a plurality of bars shown on a product (tag 12 on container 16), following a predetermined pattern of arrangement according to a conventional black and white bar code structure, said bars including at least three types of bars in such a manner that each of said three types of the bars has a reflected wavelength characteristic different from that of other bars among said three types of the bars so that the reflected wavelength characteristic the bars when combined forms a unit of displaying information. More specifically, Ackley teaches that A number of color elements 26-36 form the color symbol 12. For example, the color symbol 12 of FIG. 1 includes blue 26, yellow 28, red 30, green 32, white 34, and red 36 bars. (For ease of presentation, the color of each bar is represented by a letter, where B

stands for blue, Y stands for yellow, R stands for red, G stands for green, and W stands for white. In use, the symbol elements 26-36 employ the actual colors, and the letters typically do not appear on the symbol 12.) The particular color machine-readable symbol 12 shown in FIG. 1 is not intended to represent any particular symbol from any particular symbology, and the invention is not limited to any particular color symbology or physical aspects of a particular symbology. For example, the symbol 12 can employ fixed width bars, instead of the varying width color bars 26-36 shown in FIG. 1. Additionally, or alternatively, the symbol 12 can employ geometrical shapes other than bars, such as hexagons, octagons, dots, squares, or arbitrary shapes. Further, the color symbol 12 can employ fewer or greater number of colors, or different colors than those shown and discussed (see Figure 1, col 2 line 58 to col 3 line 10).

Regarding claim 7, Ackley teaches that the three types of bars include a red bar 36, a green bar 32, and a blue bar 26 (see Figure 1, col 2, lines 59-60).

Regarding claim 8, Ackley teaches that the three types of bars include a white color bar 34 and another bar with color selected from a group of red, blue, and green bars. In addition, Ackley teaches that the color symbol 12 can employ different colors than those shown and discussed, which includes the conventional black color (see Figure 1, col 2 line 58 to col 3 line 10).

Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ackley in view of Yoshinaga (U.S. Patent No. 6,073,842). The teachings of Ackley have been discussed above.

Regarding claims 9-14, Ackley fails to specifically enumerate the use of different conventional barcodes (i.e. JAN, ITF, NW-7).

Yoshinaga discloses that examples of the normal bar code are shown in FIGS. 8A, 8B, 8C and 8D. A bar code shown in FIG. 8A is a JAN type bar code which is mainly used in the food trade. A bar code shown in FIG. 8B is an NW-7 type bar code which is mainly used in the apparel trade. A bar code shown in FIG. 8C is an ITF type bar code which is mainly used in the distribution trade. A bar code shown in FIG. 8D is a CODE 39 type bar code, which is mainly used for industrial products (see Figures 8A-8D, col 3, lines 43-50). Hence, these codes are conventional and well-known in the art to consist of 13 modules, each of which consists of 7 bars and to contain a plurality of information (i.e. a national number, manufacturer number, etc.). See also the "Description of the Related Art" section of the specification of the instant application on pages 1-2, which teaches about the conventional properties of these codes.

In view of the teaching of Yoshinaga, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ one of the conventional codes because these codes are well known to be efficient to store and be able to display data. In addition, since they are conventional, there is a standard that is upheld and the codes are able to be read by conventional, standardized readers which is favorable because the codes are more easily and universally read.

(10) Response to Argument

The arguments of the appellant under sections "A" and "B" on pages 4-5 of the appeal brief are not persuasive since the affidavit, as supplemented in the reply filed 12

September 2005, is not deemed effective to disqualify the Ackley reference as prior art under 35 USC 102(e) against the appellant.

It is argued that because the instant application "claims the priority benefit of U.S. provisional application No. 60/170,170,815 filed December 15, 1999" and "Japanese unexamined patent publication No. 11-161757 was filed on November 28, 1997 and published on June 18, 1999, within one year of the filing date of the US provisional application No. 60/170,815," which is 15 December 1999, the appellant is entitled to rely on the Japanese publication No. 11-161757 to establish prior invention and, accordingly, disqualify Ackley as prior art since Ackley's filing date was October 18, 1999.

35 USC 119(a) prohibits reliance on earlier-filed foreign application if such application was filed more than one year before the filing date of the corresponding US application for patent. In *Stevens v. Tamai*, 70 USPQ2d 1765 (Fed. Cir. 2004), it is stated that "Section 119(a) of title 35 precludes relying on a foreign application for priority benefit when that application was filed more than one year before the filing of the corresponding US application." Quoting *Schmierer v. Newton* (158 USPQ 203 (CCPA 1968)).

Appellant apparently mis-interpreted the statute to allow asserting priority benefit of the filing date of a foreign application if a later filed provisional application was filed within one year of the filing date of the foreign application. This is not a proper interpretation of section 119(a) since 119(a) is available for an application for a patent and not for a provisional application which is not an application for a patent. The filing

of a provisional application sets the earliest date of that application to the child application. The appellant did not file a U.S. application, but rather a provisional application. Accordingly, the argument that the appellant is entitled to rely on the prior filing date of the Japanese application, filed more than one year before December 4, 2000, the filing date of the earliest non-provisional application No. 09/729,414, is not persuasive.

Because the prohibition regarding relying on the filing date of an earlier foreign application which was more than one year from the filing date of a non-provisional application for patent under 35 USC 119(a), the affidavit may at best be sufficient to show conception as of the applicant's foreign filing date of November 28, 1997 but is not adequate to establish constructive reduction to practice. As such, in order to disqualify Ackley as a 102(e) reference, diligence must be shown from the date of conception to the filing date of the Ackley reference. For example, the U.S. provisional application was filed December 15, 1999, over two years past the constructive reduction to practice date. No diligence is shown regarding the time between the conception date (November 28, 1997) as argued by the appellant and the provisional application date of December 15, 1999. Due to a lack of claimed diligence, the arguments are not persuasive and therefore do not preclude the rules regarding dates and filings of foreign applications, U.S. applications, and provisional U.S. applications. Examiner respectfully submits that, absent a showing of diligence, the evidence is insufficient to disqualify Ackley as a 102(e) reference.

Furthermore, it is respectfully submitted that a foreign application, with which no priority benefit under 35 USC 119 could have been claimed in a subsequent US application that was filed more than one year from the filing date of the foreign application (and such priority benefit was not claimed in the instant application thus forfeiting any rights to the foreign priority date), cannot be relied on to establish a constructive reduction to practice. It is inoperative for any purpose, save as evidence of conception. In order to overcome a prior art reference under section 102(e) appellants must either satisfy the substantive requirements of Rule 131 or establish that the relevant disclosure describes their own invention. In establishing prior invention to overcome the Ackley reference appellants cannot rely on their earlier filed Japanese application as a constructive reduction to practice of the invention. The evidence presented by appellants is not sufficient to establish invention prior to the effective date of the reference under Rule 131. See *In re Costello*, 219 USPQ 389. (*Fed. Cir.* 20 September 1983).

In response to the appellant's arguments under section "C" on page 5 of the appeal brief, examiner respectfully submits that the arguments in this section are moot since no rejection was ever made regarding the Japanese patent application No. 9-328040.

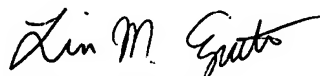
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 2876

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



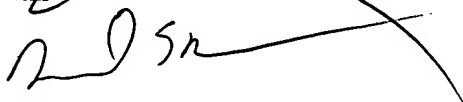
Lisa M. Caputo

4 December 2006

Conferees:



Mr. Michael G. Lee



Mr. David Blum